

REMARKS

Initially, Applicant would like to express appreciation to the Examiner for the detailed Official Action provided, for the acknowledgment of Applicant's Information Disclosure Statements (IDS) by return of the Form PTO-1449, and for the acknowledgment of Applicant's Claim for Priority and Receipt of the certified copy of the priority documents in the Official Action. Upon entry of the present amendment, claims 1 and 3 will have been amended, claim 2 will have been canceled, and claims 16-19 will have been added. Claims 1 and 3-19 remain pending in the present application. Applicant has amended claim 3 to conform this claim to the amendment made to claim 1.

Applicant gratefully acknowledges the Examiner's indication of the allowability of claims 2, 3 and 7. In this regard, Applicant notes that independent claim 1 has been amended to incorporate the limitations of allowable claim 2 (and claim 2 has been canceled). Applicant further notes that newly-added independent claim 16 generally corresponds to independent claim 1 and allowable claim 3, that newly-added independent claim 17 generally corresponds to independent claim 1 and allowable claim 7, and that newly-added independent claim 18 generally corresponds to claims 1, 4 and 5.

The Examiner has objected to claim 5 because of parentheses. In compliance with the Examiner's suggestion, Applicant has deleted the parentheses from this claim, and respectfully requests withdrawal of this objection.

The Examiner has rejected claims 1, 4, 8-10 and 13-15 under 35 U.S.C. § 102 (b) as being anticipated by OBARA (U.S. Patent No. 6,186,627). As discussed above and solely in order to advance the prosecution of the present application as discussed above,

Applicant has amended independent claim 1 to incorporate the limitations of allowable claim 2, which should not be taken as an acquiescence by Applicant as to the appropriateness of the rejection. Further, Applicant expressly reserves the right to submit claims of a related scope in another application. Thus, the cancellation of the claims in the present application is without prejudice.

The Examiner has rejected claims 1, 4-6, 8-10 and 13-15 under 35 U.S.C. § 102 (b) as being anticipated by BAUDART et al. (U.S. Patent No. 6,318,859, hereinafter BAUDART I). As discussed above and solely in order to advance the prosecution of the present application as discussed above, Applicant has amended independent claim 1 to incorporate the limitations of allowable claim 2, which should not be taken as an acquiescence by Applicant as to the appropriateness of the rejection. Also as noted above, Applicant expressly reserves the right to submit claims of a related scope in another application. Thus, as noted above, the cancellation of the claims in the present application is without prejudice.

Also as noted above, Applicant has combined claims 1, 4 and 5 (which have been rejected in view of BAUDART I) into new independent claim 18, and respectfully traverses the Examiner's rejection in this regard. Specifically, Applicant notes that the change of average transmission power of the upper portion of the lens of BAUDART I, as shown, *inter alia*, in Figs. 19 and 22 is approximately 0.3 diopters. As such, Applicant notes that 0.3 diopters is numerically insignificant to the point that such a change is not noticeable by the wearer. Therefore, it is respectfully submitted that BAUDART I fails to teach or suggest at least the limitation that the average transmission power within said upper portion changes

continuously from a lower end of said upper portion to a top end of said spectacle lens, as substantially claimed in claim 18. Additionally, Applicant submits that U.S. Patent No. 6,382,789 to BAUDART et al. (hereinafter BAUDART II), as shown, *inter alia*, in Fig. 35 neither anticipates or suggests the present claimed invention.

With respect to the Examiner's rejection of claims 1, 4-5, 8-12 and 15 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2004/008320 to SHIRAYANAGI (commonly-assigned to PENTAX Corporation), in order to expedite the allowance of the present application, Applicant submits herewith a verified translation of the priority document (having a Japanese filing date of September 10, 2002, which is before the U.S. filing date of July 9, 2003 of the SHIRAYANAGI application), thereby perfecting priority of the present application under 35 U.S.C. § 119 and removing SHIRAYANAGI as a reference. It is therefore respectfully requested that the Examiner withdraw the rejection under 35 U.S.C. § 102(e) based on this reference.

With respect to the Examiner's rejection of dependent claims 4-6, 8-10 and 13-15, Applicant submits that these claims (as well as newly-added dependent claim 19) are dependent from allowable independent claim 1 (and claim 19 is dependent from allowable independent claim 18), which is allowable for at least the reasons discussed *supra*. Thus, these dependent claims (as well as newly-added claim 19) are also allowable for at least the reasons discussed *supra*. Further, all dependent claims set forth a further combination of elements neither taught nor disclosed by any of the applied references.

Absent a disclosure in a single reference of each and every element cited in a claim, a *prima facie* case of anticipation cannot be made under 35 U.S.C. § 102. Since the

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applied reference fails to disclose each and every element recited in independent claims 1 and 16-18, these claims, and the claims dependent therefrom, are not anticipated thereby. Accordingly, the Examiner is respectfully requested to withdraw the rejection of the claims under 35 U.S.C. § 102.

Thus, Applicant respectfully submits that each and every pending claim of the present application meets the requirements for patentability under 35 U.S.C. § 102, and respectfully requests the Examiner to indicate the allowance of each and every pending claim in the present application.

COMMENTS ON STATEMENT OF REASONS FOR THE INDICATION OF
ALLOWABLE SUBJECT MATTER

In response to the Statement of Reasons for the Indication of Allowable Subject Matter, mailed by the U.S. Patent and Trademark Office on November 30, 2004, along with the above-noted Official Action, Applicant wishes to clarify the record with respect to the basis for patentability of the allowed claims in the present application. In this regard, while Applicant does not disagree with the Examiner's indications that certain identified features are not disclosed by the prior art references, as noted by the Examiner, Applicant further wishes to clarify that each of the independent claims in the present application recites a particular combination of features, and the basis for patentability of each of these claims is further based on the particular totality of the features recited therein. The dependent claims set forth additional basis for their patentability in accordance with their recited limitations as well as in accordance with the particular limitations of the respective base claims.

SUMMARY AND CONCLUSION

In view of the fact that none of the art of record, whether considered alone, or in any proper combination thereof, discloses or suggests the present invention, reconsideration of the Examiner's action and allowance of the present application are respectfully requested and are believed to be appropriate.

Applicant notes that this amendment is being made to advance prosecution of the application to allowance, and with respect to newly-added independent claims 16-17 as well as the allowable features incorporated into claim 1, should not be considered as surrendering equivalents of the territory between the claim prior to the present amendment and the amended claims. Further, no acquiescence as to the propriety of the Examiner's rejection is made by the present amendment. All other amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

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Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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